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EXAMINER

SHANNON, MICHAEL R

ART UNIT PAPER NUMBER

2614

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,115

Applicant(s)

CORVIN, JOHNNY B.

Examiner

Michael R Shannon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 and 40-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16 and 40-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4 and 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14-16, 40-51, 53-56, 58-61, 63-66, and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by Hite (U.S. Patent 5,774,170), cited by applicant.

The Hite reference discloses a system and method for delivering targeted advertisements to consumers. Hite teaches a system and method for targeting and delivering advertisements to consumers via a cable/satellite broadcast and a consumer-end set-top box (point of usage) with integrated recording device and CPU. Detecting and analyzing the CID (Commercial Identifier) of a broadcast commercial enables Hite to provide a means of replacing/substituting and consequently displaying commercials. Those claims referencing a machine-readable medium are rejected based on the information found below and the fact that Hite points out, in column 4, lines 1 thru 3 that his processor is “programmed to find and analyze....”

With regards to claim 14, the claimed method is met as follows: The claimed step of “detecting the forced advertisement in an incoming video stream” is met by column 4, lines 3-13, where Hite states, “at the point of usage, a Commercial Processor (CP) is programmed to find and analyze the CID codes in each commercial.” The claimed step of “displaying the forced advertisement” is met by column 4, lines 5-8,

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where Hite states, "when a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer." The claimed step of "continuing to present the forced advertisement after the television viewer turns on and off user equipment on which the forced advertisement was being presented" is met inherently. The nature of Hite's system and the broadcast television system in general, inherently teach the fact that once a commercial is being viewed by a user, the user can turn off and on the display, and if done within a timeframe less than the remainder of the commercial, the commercial will still be playing. Although the commercial will not begin playing at the point of termination when the display was turned off, it will none-the-less continue to play and the user will be forced to watch the commercial if they want to continue to watch the current channel.

With regards to claim 40, the claimed system is met as follows: The claimed "processor that determines the forced status of an incoming advertisement and that continues to present the forced advertisement after the television viewer turns on and off user equipment on which the forced advertisement was being presented" is met by column 3, line 53 – column 4, line 11. Hite discusses the classification and preemptability of delivered commercials. Hite also states, "at the point of usage, a Commercial Processor (CP) is programmed to find and analyze the CID codes in each commercial. When a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer." The nature of Hite's system and the broadcast television system in

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general, inherently teaches the fact that once a commercial is being viewed by a user, the user can turn off and on the display, and if done within a timeframe less than the remainder of the commercial, the commercial will still be playing. Although the commercial will not begin playing at the point of termination when the display was turned off, it will none-the-less continue to play and the user will be forced to watch the commercial if they want to continue to watch the current channel. The claimed "display that displays the forced advertisement" is met by Figure 5 and column 4, lines 5-8, where Hite states, "when a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer."

With regards to claim 43, the claimed system is met as follows: The claimed "means for detecting the forced advertisement in an incoming video stream" is met by column 4, lines 3-13, where Hite states, "at the point of usage, a Commercial Processor (CP) is programmed to find and analyze the CID codes in each commercial." The claimed "means for displaying the forced advertisement" is met by column 4, lines 5-8, where Hite states, "when a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer." The claimed "means for continuing to present the forced advertisement after the television viewer turns on and off user equipment on which the forced advertisement was being presented" is met inherently. The nature of Hite's system and the broadcast television system in general, inherently teach the fact that once a commercial is being viewed by a user, the user can turn off and on the display, and if

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done within a timeframe less than the remainder of the commercial, the commercial will still be playing. Although the commercial will not begin playing at the point of termination when the display was turned off, it will none-the-less continue to play and the user will be forced to watch the commercial if they want to continue to watch the current channel.

With regards to claim 46, see the above rejection for claim 43, with the added fact that Hite points out, in column 4, lines 1 thru 3 that his processor is "programmed to find and analyze...."

With regards to claim 15, 41, 44, and 47, Hite teaches a system and method for "locking up" an advertisement in the program. In other words, Hite teaches a way to prevent "channel surfing." Hite teaches the ability to prevent the television from changing channels during playing of the advertisement (see column 8, lines 3-16).

With regards to claim 16, 42, 45, 48, 50, 55, 60, and 65, Hite teaches the ability to also store and consequently display an advertisement at the "point of usage." Column 6, line 60 thru column 7, line 14 clearly teach the ability to store and display commercials at the user-end set-top box.

With regards to claim 49, the claimed method is met as follows: The claimed step of "receiving a broadcast advertisement in a video stream" is met by column 4, lines 3-13, where Hite states, "at the point of usage, a Commercial Processor (CP) is programmed to find and analyze the CID codes in each commercial." The claimed step of "determining that the broadcast advertisement is associated with a first advertiser" is met by column 3, lines 45 thru 64, where Hite teaches the idea of "preemptability,"

which Hite uses as a way to teach substitution and replacement of commercials with other more suitable commercials. Hite offers an example of NOT using a competitor's commercial to preempt another. This logic can easily be reversed, and we could arrive at the idea of replacing a competitor's commercial with the broadcast commercial.

Either way, Hite teaches the ability to replace and substitute commercials. The claimed step of "selecting a forced advertisement associated with a second advertiser to replace the broadcast advertisement, wherein the second advertiser is a competitor of the first advertiser" is met by the preceding argument and column 7, lines 20-30 where Hite states, "if there was a CID at a break, the processor would apply the display rules for the stored, addressable ads. If there was an ad to display, it would substitute the addressed ad for the default ad". The claimed step of "displaying the forced advertisement on the display" is met by the above arguments and column 4, lines 5-8, where Hite states, "when a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer."

With regards to claim 54, the claimed system is met as follows: The claimed "means for receiving a broadcast advertisement in a video stream" is met by column 4, lines 3-13, where Hite states, "at the point of usage, a Commercial Processor (CP) is programmed to find and analyze the CID codes in each commercial." The claimed "means for determining that the broadcast advertisement is associated with a first advertiser" is met by column 3, lines 45 thru 64, where Hite teaches the idea of "preemptability," which Hite uses as a way to teach substitution and replacement of

commercials with other more suitable commercials. Hite offers an example of NOT using a competitor's commercial to preempt another. This logic can easily be reversed, and we could arrive at the idea of replacing a competitor's commercial with the broadcast commercial. Either way, Hite teaches the ability to replace and substitute commercials. The claimed "means for selecting a forced advertisement associated with a second advertiser to replace the broadcast advertisement, wherein the second advertiser is a competitor of the first advertiser" is met by the preceding argument and column 7, lines 20-30 where Hite states, "if there was a CID at a break, the processor would apply the display rules for the stored, addressable ads. If there was an ad to display, it would substitute the addressed ad for the default ad". The claimed "means for displaying the forced advertisement on the display" is met by the above arguments and column 4, lines 5-8, where Hite states, "when a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer."

With regards to claim 59, the claimed system is met as follows: The claimed "display device" is met by column 4, lines 5-8, where Hite states, "when a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer." The claimed "processing circuitry configured to receive a broadcast advertisement in a video stream" is met by column 4, lines 3-13, where Hite states, "at the point of usage, a Commercial Processor (CP) is programmed to find and analyze the CID codes in each commercial." The claimed "processing circuitry configured to determine that the broadcast

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advertisement is associated with a first advertiser” is met by column 3, lines 45 thru 64, where Hite teaches the idea of “preemptability,” which Hite uses as a way to teach substitution and replacement of commercials with other more suitable commercials. Hite offers an example of NOT using a competitor’s commercial to preempt another. This logic can easily be reversed, and we could arrive at the idea of replacing a competitor’s commercial with the broadcast commercial. Either way, Hite teaches the ability to replace and substitute commercials. The claimed “processing circuitry configured to select a forced advertisement associated with a second advertiser to replace the broadcast advertisement, wherein the second advertiser is a competitor of the first advertiser” is met by the preceding argument and column 7, lines 20-30 where Hite states, “if there was a CID at a break, the processor would apply the display rules for the stored, addressable ads. If there was an ad to display, it would substitute the addressed ad for the default ad”. The claimed “processing circuitry configured to direct the display device to display the forced advertisement” is met by the above arguments and column 4, lines 5-8, where Hite states, “when a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer.”

With regards to claim 64, see the above rejection for claim 59, with the added fact that Hite points out, in column 4, lines 1 thru 3 that his processor is “programmed to find and analyze....”

With regards to claim 51, 56, 61, and 66, Hite teaches the use of CIDs (Commercial Identifiers) to identify and substitute/replace advertisements (see column

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3, lines 42-44). Hite also teaches the use of program identification codes and context codes which serve to identify the type and content of the commercial (see column 4, lines 34-40).

With regards to claim 53, 58, 63, and 68, Hite teaches the substitution and replacement of a commercial based on its CID code for the duration of the broadcast commercial (see column 7, lines 15-30).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 52, 57, 62, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite (U.S. Patent 5,774,170) in view of Welsh (U.S. Patent 4,857,999), newly cited.

Hite discloses all of the claim limitations discussed above. However, Hite does not disclose the specific idea of identifying a program based on its associated closed captioning data. Welsh discloses the idea of identifying a commercial based on its closed captioning data (see Welsh abstract). At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the detection of closed captioning data of Welsh into the method and system for detecting commercials of Hite, in order to simplify the detection process and allow commercial detection to be done using already existing data (closed captioning data) being transmitted in the broadcast.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fukuda (U.S. Patent Number 6,751,800) discloses a way to disable a viewer ability to turn off multimedia information. In a specific example, he points out that, regardless of the viewer's intent, the viewer may not turn off a commercial (see Column 8, line 63 – Column 9, line 7).

Hendricks (U.S. Patent Number 5,734,853) discloses an introductory menu with integrated advertisements that the viewer MUST watch on power-up (see Column 24, lines 55-65).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R Shannon whose telephone number is (703) 305-6955. The examiner can normally be reached on M-F 7:30-5:00, alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael R Shannon
Examiner
Art Unit 2614

July 15, 2004
M.R.S.



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